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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/992,369	11/06/2001	Hongbiao Li	5011-0005	5575

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EXAMINER

HOLLOWAY III, EDWIN C

ART UNIT	PAPER NUMBER
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2635

DATE MAILED: 06/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/992,369

Applicant(s)

LI, HONGBIAO

Examiner

Edwin C. Holloway, III

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 14-21 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-12 and 14-21 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

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Examiner's Response

1. In response to applicant's amendment filed 3-15-05, all the amendments to the specification and claims have been entered. The examiner has considered the new presentation of claims and applicant's arguments in view of the disclosure and the present state of the prior art. And it is the examiner's opinion that the claims are unpatentable for the reasons set forth in this Office action:

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-12 and 14-21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitation of "separate" stored data in claim 1 line 3 and claim 12 line 5 is not described in the specification as originally filed.

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Supplemental data used in conjunction with resultant data to compare with authentication data in claim 7 is not described in the specification as originally filed because the disclosed resultant data Y is compared to the authentication data Z in fig. 2 step 106 without any description of supplemental data.

Claim Rejections - 35 USC § 102 & 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 1-8, 10-12 and 14-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moore (US 5592561) in view of Kaish (US 5974150) and McCalmont (US 4856063).

Regarding claims 1 and 12, Moore discloses a system and method including an authenticator (host computer 14) with a processor (col. 20 line 2) storing authentication data (database in col. 20 lines 10-20 and col. 10 lines 24-37). A product (goods) stores product data in col. 12 lines 29-46 that is extracted by an interface (field reader 18) and sent to the authenticator in col. 20 lines 31-54 for comparison to the authentication data to determine that the product is authentic if comparison is acceptable in col. 19 lines 20 - col. 20 line 9. Moore discloses decoding or deciphering the extracted product data prior to comparison, but does not expressly state that the decryption combines separate stored data with the

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extracted product data to form resultant data for comparison.

Kaish discloses an analogous art system and method for authentication of goods having authentication device with secure memory storing decryption keys in col. 25 line 62 and means to erase secure authentication memory upon detecting tampering such as improper access in col. 17 lines 17-25 and col. 25 lines 7-41.

McCalmont discloses in col. 1 lines 13-25 that common cryptographic systems include a combining plain text with an encryption key by modulo-2 addition to provide cipher data and combining the cipher text with a decryption key by modulo-2 addition to recover the plain text.

Regarding claims 1-8, 10, 12 and 14-18, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included in Moore decoding of the extracted, encrypted product data by combining a decryption key with the product data because McCalmont discloses that it is common in cryptographic communication to recover or decode cipher text or data by combining the cipher text with a decryption key by addition. The lack of any particular encryption/decryption algorithm in Moore, suggests combination with McCalmont to define the common encryption/decryption algorithm. It further, would have been obvious to have included

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in Moore the storing of the decryption key in authenticator as disclosed in Kaish to provide a secure decryption key. This key is stored separate, as best understood.

Regarding claims 11 and 19, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included the erasing of memory in response to improper access of Kaish in the system and method of Moore in order to provide secure memory that is protected against tampering and suggested by Moore discussing a tamper proof card with memory in col. 9 lines 50-55.

Regarding claims 2-3 and 17-18, the product data is concealed by extraneous data 56 in col. 15 lines 22-40 of Moore. Also, the markings are not readily visible to the eye in col. 12 line 46 - col. 13 line 7 and col. 15 lines 50-64 of Moore. Regarding claim 4, different types of data (manufacturer ID, place of manufacture, UPC, logo, etc.) are included in col. 12 lines 29-46, col. 13, lines 18-30 and col. 14 lines 4-53 of Moore. Regarding claim 5 and 15, Moore includes comparing a range in col. 29 lines 23-27 and col. 2 lines 29-35. Regarding claims 6 and 16, Moore includes comparing a distinctive value because symbols are compared in col. 19 lines 20-25 and the symbols are distinct in col. 13 lines 20-25 and unique in col. 15 lines 22-28. Further col. 19 lines 28-39 of Moore includes

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checking origin data that is a distinct value. Regarding claim 7, the host database of Moore includes supplemental data such as audit trail information in col. 22 lines 8-20 and other pertinent information in col. 8 line 5. Regarding claims 8, 10 and 14, visual indication (display) of acceptable comparison (valid) and not acceptable comparison (invalid) is provided in col. 8 lines 1-9 of Moore.

6. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Moore (US 5592561) in view of Kaish (US 5974150) and McCalmont (US 4856063) as applied above in view of Doljack (US 6442276). Doljack discloses an analogous art system for authenticating goods with either audible or visual indicator comparison in col. 9 lines 9-50. In particular, see col. 9 line 14. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included audible indication of Doljack in the system of Moore because Moore includes visual indication and Doljack teaches that audible and visual indication are interchangeable for indicating whether goods are authentic or counterfeit.

7. Claims 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Moore (US 5592561) in view of Kaish (US 5974150) and McCalmont (US 4856063) as applied above in view of Chainer (US 6397334). Chainer discloses a method and system for

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authenticating objects using encrypted measured parameters related to the object such as temperature and odor (smell). See col. 3 line 5 and col. 7 line 27-31. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included the measurement of parameters such as temperature or odor as disclosed in Chainer in the combination applied above to reduce fraud.

8. Claims 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Moore (US 5592561) in view of Kaish (US 5974150) and McCalmont (US 4856063) and Chainer (US 6397334) as applied above in view of Urbas (5525962). Urbas discloses a transponder with temperature sensor 19 encapsulated in a protective glass capsule 28. The transponder and sensor are on a single chip to provides efficiencies in size and cost. See col. 2 lines 37-40 and col. 10 line 54 - col. 11 line 9. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included the temperature sensor in a capsule as discloses in Urbas in the combination applied above for protective encapsulation and efficiency in size and cost.

Response to Arguments

9. Applicant's arguments filed 3-15-05 have been fully considered but they are not persuasive and/or are moot in view

of the new ground(s) of rejection.

Initially it is noted that new claims 20-21 should have been labeled "new" rather than -added--. Although the amendment was entered, it could have been denied entry under 37 CFR 1.121

Applicant argues that Moore merely decrypts encrypted data retrieved from a product to detect authenticity rather than combining retrieved product data with stored data. This argument is not persuasive because the typical decryption process involves combining the encryption data with a number that is called a key. McCalmont is applied to define a common decryption technique including combining a cipher text with a key by addition. Kaish is applied to teach storing of the key in secure memory of the authenticator for protection.

The arguments regarding new claims 20-21 are moot in view of the new grounds of rejection rely on Chainer and Urbas to disclose these features.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Howell (GB 2308947) discloses an RF tag with temperature sensory to store temperature history of a product.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS**

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ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

CONTACT INFORMATION

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact an Electronic Business Center (EBC) representatives at 703-305-3028 or toll free at 866-217-9197 between the hours of 6 a.m. and midnight Monday through Friday EST, or by e-mail at ebc@uspto.gov. The Patent EBC is a complete customer service center that supports all Patent e-business products and service applications. Additional information is available on the Patent EBC Web site at <http://www.uspto.gov/ebc/index.html>.


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Any inquiry of a general nature should be directed to the Technology Center 2600 receptionist at (571) 272-2600.

Facsimile submissions may be sent via fax number (703) 872-9306 to customer service for entry by technical support staff. Questions regarding fax submissions should be directed to customer service voice line (703) 306-0377.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edwin C. Holloway, III whose telephone number is (571) 272-3058. The examiner can normally be reached on M-F (8:30-5:00). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on (571) 272-3068.

EH
6/10/05


EDWIN C. HOLLOWAY, III
PRIMARY EXAMINER
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